

JAN 05 2007

PATENT

Docket No. 275.0003 0103

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): LI et al. ) Group Art Unit: 1635  
 )  
 Serial No.: 10/772,661 ) Examiner: Tracy Ann Vivlemore  
 Confirmation No.: 5608 )  
 )  
 Filed: February 5, 2004 )  
 )  
 For: COMPOSITION AND METHOD FOR *IN VIVO* AND *IN VITRO* ATTENUATION OF  
 GENE EXPRESSION USING DOUBLE STRANDED RNA

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2. 1449 FORMS (31 PGS)

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By: David L. Provence  
 David L. Provence  
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 Name: Sandy Truehart

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JAN 05 2007

PATENT

Docket No. 275.00030103

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Li et al. ) Group Art Unit: 1635  
Serial No.: 10/772,661 )  
Confirmation No.: 5608 ) Examiner: Tracy Ann Vivlemore  
Filed: February 5, 2004 )  
For: COMPOSITION AND METHOD FOR IN VIVO AND IN VITRO  
ATTENUATION OF GENE EXPRESSION USING DOUBLE STRANDED  
RNA

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with the continuing duty of candor and good faith that is to be demonstrated before the United States Patent and Trademark Office (USPTO), enclosed are copies of documents which Applicants bring to the Examiner's attention as possibly being of interest in connection with the above-identified patent application. Per M.P.E.P. § 609, the information cited in the present Information Disclosure Statement shall not be construed to be an admission that the information is, or is considered to be, material to patentability. Consideration of the documents listed on the attached 1449 form are respectfully requested. Pursuant to the provisions of MPEP §609, Applicants further request that a copy of the 1449 form, marked as being considered and initialed by the Examiner, be returned with the next Official Communication.

Applicants would also like to bring to the Examiner's attention Benitec v. Nucleonics Civil Action No. 04-CV-0174 (JJF) in the U.S. District Court for the District of Delaware. Certain documents cited herein were first brought to the Applicants' attention in a search of literature related to this action.

**Supplemental Information Disclosure Statement**

Page 2 of 3

Applicant(s): LI et al.

Serial No.: 10/772,661

Confirmation No.: 5608

Filed: February 5, 2004

For: *COMPOSITION AND METHOD FOR IN VIVO AND IN VITRO ATTENUATION OF GENE EXPRESSION USING DOUBLE STRANDED RNA*

**Should the Examiner wish to review any documents in Applicants' possession related to this action, the Examiner is invited to contact the undersigned and any documents requested will be forwarded.**

Documents U.S. Patent 5,578,716, WO 94/01550A1, Barlow et al., Beretta et al., Billy et al., Brand et al., Brummelkamp et al. (*Cancer Cell*, 2:243-247, (2002)), Burke et al., Haggarty et al., Harada et al., Kirchhoff et al., McManus et al. (*RNA*, 8:842-850 (2002)), Thoemis et al., listed on the attached Form PTO-1449 were cited in an Opposition of EP 1230375 B1.

Documents U.S. 5,631,148 (Urdea), and WO 99/32619 A1, of record, were also cited in the opposition.

Documents WO 95/27783 A1, WO 97/34638 A1, and Schaefer et al., listed on the attached Form PTO-1449 were cited in a foreign search or examination report corresponding to Korean application serial no. 10-2001-7013385 and mailed on August 8, 2006. This application has inventors in common with the instant application.

An English translation of non-English document, Zakharyan et al., is attached to the document. U.S. Patent 5,798,265 is being submitted as an English language equivalent of non-English document, EP 0 560 156 A2. An English abstract of non-English publications WO 92/19732 A1, WO 95/18223 A1, and WO 98/05770 A2, may be found on the cover page of the publication. An English abstract of non-English publications JP 09-110894 A and JP 09-227413 may be found attached to the publication.

This application is a continuation of U.S. Patent Application Serial No. 10/038,984, filed January 4, 2002, which is a continuation of U.S. Patent Application Serial No. 09/493,301, filed January 28, 2000 (Abandoned). In accordance with 37 C.F.R. §1.98(d), copies of documents previously cited by or submitted to the U.S. Patent and Trademark Office in connection with Applicants' prior application(s) listed above, are not included herewith.

**Supplemental Information Disclosure Statement**

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Applicant(s): LI et al.

Serial No.: 10/772,661

Confirmation No.: 5608

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For: COMPOSITION AND METHOD FOR IN VIVO AND IN VITRO ATTENUATION OF GENE EXPRESSION USING DOUBLE STRANDED RNA

Since this Information Disclosure Statement is submitted after the receipt of an Office Action in the above-identified patent application, please charge the fee of \$180 under 37 C.F.R. §§1.97(c) and 1.17(p), and any additional fees or credit any overpayment to Deposit Account No. 13-4895.

When the Examiner takes up the present application, consideration of these documents is respectfully requested. The Examiner is invited to contact Applicants' Representatives at the below-listed telephone number, if they can be of any assistance during prosecution of the present application.

**CERTIFICATE UNDER 37 C.F.R. 1.8:**

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

on this 5 day of JAN., 2007, at 3:45pm (Central Time).

Sandy Truehart  
Name: Sandy Truehart

Respectfully submitted for  
LI et al.

By

Mueeting, Raasch &amp; Gebhardt, P.A.

P.O. Box 581415

Minneapolis, MN 55458-1415

Telephone (612)305-1220

Facsimile (612)305-1228

Customer Number 26813

January 5, 2007  
Date

By: David L. Provence  
David L. Provence  
Reg. No. 43,022  
Direct Dial (612)305-1005

JAN 05 2007

**INFORMATION DISCLOSURE CITATION**

(Use several sheets if necessary)

PTO Form 1449

Attorney Docket No.  
275.00030103Application No.  
10/722,661Applicants: Li *et al.*

PAGE 1 of 31

Information Disclosure Statement Mailed :

January 5, 2007

Filing Date: February 5, 2004

Group Art Unit: 1635

**U.S. PATENT DOCUMENTS**

Initial	Copy Enclosed	Document No.	Date	Name	Class	Sub-Class	Filing Date
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Examiner			Date Considered				

Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

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<b>INFORMATION DISCLOSURE CITATION</b> (Use several sheets if necessary)				Attorney Docket No. 275.00030103		Application No. 10/722,661	
PTO Form 1449				Applicants: Li <i>et al.</i> Information Disclosure Statement Mailed :		PAGE 3 of 31 January 5, 2007	
				Filing Date: February 5, 2004		Group Art Unit: 1635	
<b>FOREIGN PATENT DOCUMENTS</b>							
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Examiner

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<b>OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)</b>			
<b>Initial</b>	<b>Copy Enclosed</b>		
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		Annex B filed in EP 99 910 039.9 (September 9, 2005).	
		Annex C filed in EP 99 910 039.9 (September 9, 2005).	
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<b>Examiner</b>		<b>Date Considered</b>	
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		Applicants: Li <i>et al.</i>	
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		Filing Date: February 5, 2004	PAGE 7 of 31 January 5 2007 Group Art Unit: 1635
<b>OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)</b>			
Initial	Copy Enclosed		
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Examiner		Date Considered	
Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.			

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		Filing Date: February 5, 2004	PAGE 8 of 31 January 5, 2007 Group Art Unit: 1635
<b>OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)</b>			
Initial	Copy Enclosed		
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